REMARKS

Claims 21, 23, and 52 stand rejected under 35 U.S.C § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. As amended above, claims 21, 23, and 52, now recite the phrases "a server," "a call," "a trusted telephone network" instead of the phrases "service," "said call," and "said trusted telephone network." Furthermore, corresponding amendments are made in corresponding system claims 28 and 30. Claims 21, 23, 28, 30, and 52 as amended now have antecedent basis, are patentable, and should be allowed.

The drawings in the present application are objected to as informal. Formal drawings are submitted with this Response, thereby curing the objections to the drawings.

Claims 1 – 30 and 32 – 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Ferris (U.S. Patent No. 6,122,357). Claims 31 and 52 – 59 are rejected under 35 U.S.C § 103(a) as unpatentable over Hunt (U.S. Patent No. 5,499,288) in view of Borland (U.S. Patent No. 6, 131, 042) and over Ferris in view of Hunt. Neither Ferris, Hunt in view of Borland, nor Ferris in view of Hunt teaches "a server external to a trusted network." Claims 1-59 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually below and request reconsideration of claims 1 – 59.

Claim Rejections – 35 U.S.C. §102

Claims 1 – 30 and 32 – 51 stand rejected under 35 U.S.C § 102(e) as being anticipated by Ferris (U.S. Patent No. 6,122,357). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Because Ferris does not teach each and every element of claims 1 – 30 and 32 – 51, the rejection should be withdrawn and the claims should be allowed.

The present application in independent claim 1 claims a "method for externally identifying a particular callee" that includes "receiving a voice utterance for a callee at a server external to a trusted telephone network ..." The present application in claim 1 also claims "wherein said trusted telephone network is processing a call to said callee ..." Claim 17 in the present applications claims a "method for specifying telephone service for a particular callee" that includes "detecting a call receipt condition from a destination device at a trusted telephone network" and "brokering a connection between said destination device and an external server ... ." Similarly, claim 32 in the present application claims a "method for informing a caller of a callee identity" that includes "detecting a call receipt condition from a destination device at a trusted telephone network" and "brokering a connection between said destination device and an external server ... ."

In stark contrast to Applicants' claims, Ferris teaches, at column 1, lines 15-20, "a personalized telecommunications service, preferably offered through an intelligent telephone network." That is, one network only, with no teaching or suggestion of "a server *external* to a trusted telephone network" as claimed in claim 1 of the present application or "brokering a connection between said destination device and an external server ..." as claimed in claims 17 and 32 of the present application. In fact, by teaching only one "intelligent telephone network," Ferris teaches directly away from the claims of the present invention regarding external servers and trusted networks.

Dependent claims 2-6, 18-23, and 33-41 depend respectively from independent claims 1, 17, and 32. If claims 1, 17, and 32 stand, then claims 2 – 6, 18-23, and 33-41 stand also. As explained above in this Response, claims 1, 17, and 32 stands because Ferris does not teach an external server or trusted network and therefore does not teach each and every element of any of the claims. Because claims 1, 17, and 32 stand, claims 2-6, 18-23, and

33-41 stand also. The rejections of claims 2-6, 18-23, and 33-41 therefore should be withdrawn, and the claims should be allowed.

Independent claims 7, 24, and 42 each recite system aspects corresponding to the methods of claims 1, 17, and 32 respectively. Dependent claims 8-13, 25-30, and 43-51 depend respectively from independent claims 7, 24, and 42. Claims 7, 24, and 42 are rejected by the Examiner according to the same rationales as stated in the Office Action for the rejections of claims 1, 17, and 32. Applicants have demonstrated above, however, that claims 1, 17, and 32 and their dependencies should stand because Ferris does not teach external servers or trusted networks. Applicants respectfully propose, therefore, that the rejections of claims 7, 24, and 42, as well as their dependencies, should be withdrawn, and those claims also should be allowed.

Independent claim 14 recites computer program product aspects corresponding to the method of claim 1. Dependent claims 15-16 depend from independent claim 14. Claim 14 is rejected by the Examiner according to the same rationales as stated in the Office Action for the rejection of claim 1. Applicants have demonstrated above, however, that claim 1 and its dependencies should stand because Ferris does not teach external servers or trusted networks. Applicants respectfully propose, therefore, that the rejections of claim 14 as well as its dependencies in claims 15 and 16 should be withdrawn.

Claim Rejections – 35 U.S.C. § 103

Claims 31 and 52-59 stand rejected under 35 U.S.C § 103(a) as unpatentable over Hunt (U.S. Patent No. 5,499,288) in view of Borland (U.S. Patent No. 6, 131, 042) and over Ferris in view of Hunt. Applicants respectfully traverse each rejection. Not one of the proposed combinations can establish a prima facie case of obviousness.

To establish a prima facie case of obviousness, three basic criteria must be met. *Manual of Patent Examining Procedure* §2142. The first element of a prima facie case under 35

U.S.C. 103 is that the combination must teach or suggest all of Applicants' claim limitations. *In re Royka*, 490 F.2d 981, 985, 180 USPQ 580, 583 (CCPA 1974). The second element of a prima facie case under 35 U.S.C. 103 is that there must be a suggestion or motivation to combine the references. *In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). The third element of a prima facie case under 35 U.S.C. 103 is that there must be a reasonable expectation of success in the combination. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379 (Fed. Cir. 1986).

Hunt and Borland

The present application in independent claim 31 claims, among other things, a "computer program product for specifying telephone services for a particular callee" that includes "means ... for detecting a call receipt condition from a destination device at a *trusted* telephone network," "means ... for brokering a connection between said destination device and an *external* server ... ," and "means ... for specifying service available to said callee ... ."

Claim 31 is rejected over Hunt in view of Borland on grounds that Hunt discloses means for detecting a call receipt condition, means for brokering a connection, and means for specifying services available, but does not disclose means for specifying a telephone service for a particular callee. The Examiner states that Borland, however, does disclose a method of identifying a particular callee and that it would have been obvious to one of ordinary skill in the art to modify the computer program product of Hunt to include the method from Borland for specifying telephone service for a particular callee.

The combination of Borland and Hunt does not teach or suggest all of Applicants' claim limitations. In issuing a rejection for obviousness, the examiner must point to teaching within Borland or Hunt that suggests their combination. Absent such a showing, the examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to hunt through the prior art for the claimed elements and combine them as claimed. *In re*

Surko, 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Hunt in view of Borland do not teach a trusted telephone network or an external server as claimed in the present application, therefore, the combination cannot be said to teach or suggest all of Applicants' claim limitations.

There is no suggestion or motivation to combine Hunt and Borland because the references themselves teach away from the claims of the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.,* 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson,* 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Hunt in view of Borland particularly teaches away from a trusted telephone network or an external server as claimed in the present application. In fact, Hunt and Borland both are very clearly directed to operations of a single telephone network. Neither Borland nor Hunt sets forth any disclosure or suggestion whatsoever regarding more than one kind of network, external networks, internal networks, trusted networks, or untrusted networks. Hunt, for example, at column 2, line 61, describes its Figure 1 as illustrating a "block diagram of a conventional telephone network 10 ... ." That is, a single conventional telephone network. And Hunt at column 3, line 9, recites that "... the telephone network may include other devices and switching systems conventional in the art," again speaking of a single telephone network. Borland at column 1, line 10, teaches, "Telephone subscribers communicate via a vast telephone network, referred to as the Public Switched Telephone Network (PSTN). In the present disclosure, the term "PSTN" is intended to include the analog phone network or POTS (Plain Old Telephone Service), ISDN (Integrated Services Digital Network), DSL (Digital Subscriber Line), and Wireless Local Loop (WLL), among others." That is, Borland teaches one vast network, just one. As such, Hunt and Borland, individually and

in combination, teach away from Applicants' claims. Because Borland and Hunt teach away from Applicants' claims, neither Borland, nor Hunt, nor Borland in view of Hunt can be said to represent any suggestion to combine references within the meaning of 35 U.S.C. 103, and the second element of a prima facie case of obviousness cannot be shown. Claim 31 should therefore be allowed.

There can be no reasonable expectation of the success in the combination of Hunt in view of Borland. There can be no reasonable expectation of success in a combination if the combination changes the principle of operation of either reference. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Both Hunt and Borland are for single networks. Because neither Hunt nor Borland teaches an external server or a trusted network, their combination cannot work to teach an external server or a trusted network. There is no way to combine Hunt and Borland for external servers and trusted networks without changing their principles of operation to include more than one kind of network. No combination of Hunt and Borland can be said to have any reasonable expectation of success.

Ferris and Hunt

The present application in claims 52-59 claim, among other things, a "computer program product for informing a caller of a callee identify" that includes "means ... for detecting a call receipt condition from a destination device at a *trusted* telephone network," "means ... for brokering a connection between said destination device and an *external* server ... ," and "means ... for transferring an authenticated callee identity ... ."

Claim 52-59 are rejected over Ferris in view of Hunt on grounds that Hunt discloses means for detecting a call receipt condition, means for brokering a connection, and means for specifying services available, but Farris does not disclose a recording medium. The Examiner states that it would have been obvious to one of skill in the art to modify the system of Ferris with a speech generator from Hunt in order to "have a recording medium

to broker services between a destination device and an origin device to provide services such as: callee identity authentication, provide information to the caller, indicate call transfer, and announce when a call is forwarded."

The combination of Ferris and Hunt does not teach or suggest all of Applicants' claim limitations. In issuing a rejection for obviousness, the examiner must point to teaching within Ferris or Hunt that suggests their combination. Absent such a showing, the examiner has impermissibly used "hindsight" occasioned by Applicants' own teaching to hunt through the prior art for the claimed elements and combine them as claimed. *In re Surko,* 11 F.3d 887, 42 U.S.P.Q.2d 1476 (Fed. Cir. 1997); *In re Vaeck,* 947 F.2d 488m 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re Gorman,* 933 F.2d 982, 986, 18 U.S.P.Q.2d 1885, 1888 (Fed. Cir. 1991); *In re Bond,* 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990); *In re Laskowski,* 871 F,.2d 115, 117, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Ferris in view of Hunt particularly does not teach a trusted telephone network or an external server. On the contrary, Ferris and Hunt both are very clearly directed to operations of a single telephone network. Ferris teaches, at column 1, lines 15-20, "a personalized telecommunications service, preferably offered through an intelligent telephone network." One network. Hunt, for example, at column 2, line 61, describes its Figure 1 as illustrating a "block diagram of a conventional telephone network 10 ... ." That is, a single conventional telephone network. And Hunt at column 3, line 9, recites that "... the telephone network may include other devices and switching systems conventional in the art," again, only one telephone network. Neither Ferris nor Hunt sets forth any disclosure or suggestion whatsoever regarding more than one kind of network, external networks, internal networks, trusted networks, or untrusted networks. Because neither Ferris, nor Hunt, nor Ferris in view of Hunt discloses all the elements of claim 31, the first element of a prima facie case of obviousness cannot be made out under 35 U.S.C. 103, and claim 31 should therefore be allowed.

There is no suggestion or motivation to combine Ferris and Hunt because the references themselves teach away from the claims of the present application. Teaching away from the claims is a *per se* demonstration of lack of prima facie obviousness. *In re Dow Chemical Co.,* 837 F.2d 469, 5 U.S.P.Q.2d 1529 (Fed. Cir. 1988); *In re Fine,* 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); *In re Neilson,* 816 F.2d 1567, 2 U.S.P.Q.2d 1525 (Fed. Cir. 1987). Ferris in view of Hunt particularly teaches away from a trusted telephone network or an external server as claimed in the present application. In fact, Ferris and Hunt both are very clearly directed to operations of a single telephone network. Neither Ferris nor Hunt sets forth any disclosure or suggestion whatsoever regarding more than one kind of network, external networks, internal networks, trusted networks, or untrusted networks. Ferris teaches, at column 1, lines 15-20, "a personalized telecommunications service, preferably offered through an intelligent telephone network." One network. Hunt, for example, at column 2, line 61, also teaches one telephone network, describing its Figure 1 as illustrating a "block diagram of a conventional telephone network 10 ... ." And Hunt at column 3, line 9, recites that "... the telephone network may include other devices and switching systems conventional in the art," again speaking of a single telephone network. Because Ferris and Hunt teach away from Applicants' claims, neither Ferris, nor Hunt, nor Ferris in view of Hunt can be said to represent any suggestion to combine references within the meaning of 35 U.S.C. 103, and the second element of a prima facie case of obviousness cannot be shown. Claims 52-59 should therefore be allowed.

There can be no reasonable expectation of the success in the combination of Ferris in view of Hunt. There can be no reasonable expectation of success in a combination if the combination changes the principle of operation of either reference. *In re Ratti,* 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Both Ferris and Hunt teach a single telephone network. Because neither Ferris nor Hunt teaches an external server or a trusted network, their combination cannot work to teach an external server or a trusted network. There is no way to combine Ferris and Hunt for external servers and trusted networks without

changing their principles of operation to include more than one kind of network. No combination of Ferris and Hunt can be said to have any reasonable expectation of success.

Conclusion

Ferris does not teach each and every element of claims 1-30 and 32-59, and Ferris therefore does not anticipate claims 1-30 and 32-59. The proposed combinations of Ferris, Hunt, and Borland also fail to establish a prima face case of obviousness because the proposed combinations do not teach each and every element of the rejected claims, there is no suggestion or motivation to make the proposed combinations, and there is no reasonable expectation of success in the proposed combination. Applicants therefore respectfully request the allowance of claims 1-59.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,

Date: 12.2.03 By: _____

H. Artoush Ohanian
Reg. No. 46,022
Biggers & Ohanian, PLLC
504 Lavaca Street, Suite 970
Austin, Texas 78701
Tel. (512) 472-9881
Fax (512) 472-9887
ATTORNEY FOR APPLICANTS